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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,667	12/12/2000	King W. Chiu	13409SCUS01U	5606

7590 08/24/2004

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EXAMINER

HOM, SHICK C

ART UNIT	PAPER NUMBER
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2666

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,667

Applicant(s)

CHIU ET AL.

Examiner

Shick C Hom

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 is/are allowed.
- 6) ☒ Claim(s) 1-22 and 25 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/12/01</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. Claims 2-17 and 22-23 are objected to because of the following informalities: In claims 2-17 line 1 delete "The telephone" and insert ---The IP telephony peripheral---. In claim 5 line 2 spell out acronym, i.e. delete "ASIC" and insert ---Application Specific Integrated Circuit ASIC---. In claim 23 lines 5 and 10 delete "said packet voice telephone" and insert ---said packet voice telephone peripheral---. In claim 22 line 1 delete typo "claim 20" and insert ---claim 21---. In claim 18 line 12 delete "extracted" and insert ---parsed---. Appropriate correction is required.

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Claim Rejections - 35 USC § 112

3. Claims 10, 13, and 15-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10 line 2 which recite "said extractor" lacks clear antecedent basis because no extractor have been previously recited in the claims and therefore the limitation is not clearly understood. In claims 13 and 15-17 line 1 which recite "said communicative coupling" lacks clear antecedent basis. In claim 18 lines 9 and 13 which recite "said IP telephone" lacks clear antecedent basis. In claim 20 line 1 which recite "said telephone controller" lacks clear antecedent basis. In claim 21 line 6 which recite "the extracted call request" and lines 10-11 which recite "the stored destination IP address" lack clear antecedent basis.

Claims 19 and 22 are rejected under 35 U.S.C. 112, second paragraph because they depend from rejected claims 18 and 21, respectively.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to

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exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be

commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-12 and 18-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,449,269. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claim 1 merely broaden the scope of the U.S. Patent No. 6,449,269 claim 1 by eliminating wherein said network interface captures an inbound IP packet which is now recited in dependent claim 6, an extractor coupled to said network interface which is now recited in dependent claim 7, and wherein said controller comprises a finite state machine which is now recited in dependent claim 2. The application's claims 3-

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5, 8-12 merely broaden the scope of U.S. Patent No. 6,449,269 claims 2-9, respectively. Likewise, the application's claims 18-21 correspond to the scope of the U.S. Patent No. 6,449,269 claims 10-13, respectively, and are not patentably distinct because they merely list a computer interface being coupled to said controller as in claim 18 and replacing the step of storing the IP address in a memory with the broader step of resolving the IP address as in claim 21. It has been held that the omission of a element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in

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section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Lim (6,519,251).

Regarding claim 25:

Lim discloses the article including one or more machine-readable storage media containing instructions to control an IP telephony peripheral apparatus in a communications network (see col. 5 lines 24-61 which recite the memory unit storing the control program for controlling the operation of the Internet telephony card), the instructions when executed causing a controller to: transmit a call request to the IP telephony peripheral apparatus responsive to an activation command on a computer; wherein the call request comprises control information to selectively control the operation of the IP telephony peripheral (see col. 5 lines 24-61 which recite the control unit controlling the operation of the Internet telephony card and transmitting control signals to the control unit clearly anticipate transmitting control information to control the operation of the IP telephony peripheral).

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Allowable Subject Matter

8. Claim 24 is allowed.

9. Claim 23 would be allowable if rewritten or amended to overcome the objections set forth in this Office action.

10. Claims 13-17 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kimball discloses a cellular Internet telephone.

Gallant et al. disclose a method of and system for providing intelligent network control services in IP telephony.

Sieppi discloses a method, switching means and telecommunication systems for performing data communications between subscriber stations.

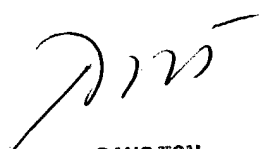
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick C Hom whose telephone number is 703-305-4742. The examiner can normally be reached on Monday to Friday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 703-308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH


DANGTON
PRIMARY EXAMINER